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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/975,230 | 10/11/2001 | Meroni Bruno | J118-104 US | 9595 |

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EXAMINER

CANTELMO, GREGG

| ART UNIT | PAPER NUMBER |
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1745

DATE MAILED: 09/13/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

MS 9

Office Action Summary

Application No.

09/975,230

Applicant(s)

BRUNO, MERONI

Examiner

Gregg Cantelmo

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1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2002 and 27 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-21 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendments

1. In response to the amendments received August 12, 2002 and August 27, 2002:
 - a. Claims 1-21 are pending with claims 1-14 now having been cancelled. An action on the merits of claims 15-21 follows;
 - b. The priority papers and issues regarding the date of the priority document have been clarified;
 - c. The drawing objections have been withdrawn in light of the amendments;
 - d. The specification objections have been withdrawn in light of the amendments;
 - e. The prior art rejection of Marino stand as applied to claims 15-19.

Election/Restrictions

2. Newly submitted claims 20 and 21 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the initial species restriction resulted in Applicant's election of the species having the metallic support member. Claims drawn to the plastic support member structure were drawn to a non-elected species.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 20 and 21 are withdrawn from

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consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

4. The amendment filed August 12, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the recitation of substantially consistent thickness regarding the walls (page 3) is not clearly supported by the original disclosure.

First the written disclosure does not appear to provide clear support for this amendment. Second the drawings do not appear to provide clear support for this amendment. For example in Fig. 1 the walls do not have consistent thickness.

Second when the specification does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000)

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 15-19 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent No. 4,045,153 (Maurino).

Maurino discloses a flexible mould FM' comprising a one-piece silicone tray comprising a bottom wall, side walls extending upwardly from the bottom wall, each side wall having an upper edge 4 and including a silicone peripheral wing extending outwardly from the upper edge of each of the side walls around the perimeter of the side walls, said wing having a peripheral edge, a wing-stiffening element 7 fixed to the wing near the peripheral edge of the wing and extending entirely around the wing, the wing stiffening element being "adapted" to stiffen said wing in order to make it possible to lift the mould by the wing so that the wing resists deformation under strain by content of the mould (Fig. 2 and col. 3, ll. 1-3, 5, and 23-32 as applied to claim 15).

Note that the stiffening agent begin "adapted" as recited in the last 4 lines of claim 15 is not accorded significant patentable weight. It has been held that the recitation that an element is "adapted" to perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138. Even so, since the prior art has the

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same structural configuration as that of claim 15, the prior art is clearly adapted to perform the same function (as applied to claim 15).

The sidewalls 2' diverge outwardly and upwardly from bottom 8' (Fig. 3 as applied to claim 16).

The wing-stiffening element 7 is at least partially encased in the silicone near the peripheral edge of the wing (Figs. 2 and 3 as applied to claim 17).

The restraining member 7 may be comprised of a plastic or metal tube, a solid metal ring or a tightly coiled spring imbedded in the periphery of the flange (col. 3, ll. 30-32 as applied to claims 18 and 19). A solid metal ring is structurally identical to a metal wire. The instant application fails to define the thickness of the wire or any structural features of the wire which would structurally distinguish it from a metal ring (as applied to claim 19).

Response to Arguments

7. Applicant's arguments filed August 27, 2002 have been fully considered but they are not persuasive.

Applicant fails to provide any clear arguments as to why the prior art rejections of record fail to anticipate the claimed invention as claimed in instant claims 15-18 and 21.

The examiner maintains that the prior art rejection of record anticipates claims 15-18 and 21 and therefore these claims are not patentably distinct from the teachings of Maurino.

The arguments filed in the amendment of August 12, 2002 are not clearly applicable since these arguments are drawn to claims 9-16 which have been cancelled.

Even if such arguments were applicable, they fail to convince the Examiner that the claims are patentably distinct from the prior art of record, as discussed herein.

For example, Applicant argues that the mould for Maurino is not necessarily within the field for trays used to cook food products. This statement does not persuade the Examiner.

Neither the intended use of the prior art of Maurino nor the intended use of the tray of the instant claims is given weight to the use of the product of the prior art or instant claims. The instant claims are drawn to a silicone tray having a rigid support member in the wing of the tray. Maurino discloses a silicone tray having a rigid support member in the wing of the tray as well.

While intended use recitations and other types of functional language cannot be entirely disregarded. However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); In re Otto, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).

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Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). See also MPEP § 2114.

The manner of operating the device does not differentiate an apparatus claim from the prior art. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

The argument in the amendment of August 12, 2002 regarding the side walls having a constant thickness is not applicable to the pending claims since such a feature is not claimed.

For the reasons set forth above, the prior art of record is held to anticipate the instant claims.

Response to Arguments

8. Applicant's arguments with respect to claim 19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

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9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregg Cantelmo whose telephone number is (703) 305-0635. The examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan, can be reached on (703) 308-2383. FAX communications should be sent to the appropriate FAX number: (703) 872-9311 for After Final Responses only; (703) 872-9310 for all other responses. FAXES received after 4 p.m. will not be processed until the following business day. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

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September 10, 2002



Patrick Ryan
Supervisory Patent Examiner
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